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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WRIGHT, ANDREW D

ART UNIT

PAPER NUMBER

3617

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,003

Applicant(s)

SMITH, ALAN DEAN

Examiner

Andrew Wright

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/26/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claims 1-3, 5, 8, 10-12, 14,-16, 18, 20, and 21 are objected to. Claim 1 recites "at least one first recognition element" and "at least one second recognition element".
2. Claim 1 subsequently recites "at least one first recognition element" and "at least one second recognition element". It is improper to positively recite the same element twice. The subsequent recitations of the same element should be preceded by the word "the" or "said" so that the reader knows that an already recited element is being referred to, and that a new element is not being recited. Claims 2, 3, 8, 14-16, 18, and 20 have similar recitations that should be preceded by "the" or "said".
3. Claim 5 subsequently recites "recognition elements". Not only should this be preceded by "the" or "said", as described above, but the recognition element should be identified as either the already recited first or second recognition element. Consistent terminology should be used throughout the claims.
4. Claim 10 subsequently recites "at least one recognition element". Not only should this be preceded by "the" or "said", as described above, but the recognition element should be identified as either the already recited first or second recognition element. Consistent terminology should be used throughout the claims. Claims 11, 12, and 21 have similar recitations.
5. Appropriate correction of objected to claim language is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 7, 14, 16-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldsen (US 5,554,062). Goldsen shows building blocks with attachable letters. A block is a structural element. A letter is a symbol that is recognized by the user. Therefore, each individual block with a letter constitutes a recognition element. Goldsen shows that at least a first and second block can be interrelated to form a combined recognition structure where the letter spell a word.

8. Regarding claim 2, the elements are stackable.

9. Claim 3, one element can be supported by another,

10. Claim 4, a known word, such as “NOT” shown in figure 4, will have a predetermined shape because the size and shape of elements is known and the arrangement to form the predetermined word is known.

11. Claim 5, purposefully forming a word such as “NOT” requires the use of a predetermined number of elements. The predetermined number of elements is the number of letters in the word.

12. Claim 7, the structure is self-standing.

13. Claim 14, the elements comprises text. The text is visible when the structure is formed.

Art Unit: 3617

14. Claim 16, each element comprises a textual character. A textual character is a symbol.

15. Claim 17, the elements have the same shape.

16. Claim 18, each element has a marking of a letter. The letter is a specific recognition.

17. Claim 20, the elements are shaped to interact with each other to form the structure.

18. Claims 1, 15, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Fulton (US 5,863,204). Fulton shows building blocks with letters and words. A block is a structural element. A letter is a symbol that is recognized by the user. Therefore, each individual block with a letter constitutes a recognition element. Fulton teaches that at least a first and second block can be interrelated to form a combined recognition structure where the letters spell a word or the words form a phrase or sentence.

19. Regarding claim 15, each element has text on at least three sides of the cube. The text can be covered and not visible in certain arrangement of the elements, such as when the elements are arranged in a straight line.

20. Regarding claims 19 and 21, the elements are cubes and can be arranged in the form of a pyramid.

21. Claims 1, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher (US 6,035,566). Fisher shows a trophy comprising silver balls and a single gold

Art Unit: 3617

ball. The silver balls are first recognition elements. The gold ball is a second recognition element. The elements are interrelated to form the trophy which is a recognition structure.

22. Regarding claim 6, the balls are poured into a dome, resulting in an arbitrary shape.

23. Claim 8, the gold ball is larger than the silver balls.

24. Claims 1, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobrzynski (US Des. 281,791). The plurality of discs (figure 1) comprise first and second elements. The elements are arranged to form a combination structure (figure 2). The square board is a retention structure. The elements are placed relative to each other within the retention structure. The elements are cylindrical. The retention structure has slots that receive the cylindrical elements.

25. Claims 1, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Barry (US 234,223). The plurality of cylinders (C) comprise first and second elements. The elements are arranged to form a combination structure. The rod (A) and handle (B) form the retention structure. The elements are cylinders with holes. The retention structure comprises a rod that engages the holes.

26. Claims 1, 9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Buschman (US 3,829,996). Block (10a) is first element. Block (10b) is second element.

The elements are arranged to form a combination structure. The housing (24) is the retention structure. The elements are held with the retention structure to form the recognition structure. The recognition structure can be expanded by adding other blocks (10c, 10d).

27. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

28. Claims 1, 9, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheng (US 6,702,285). The individual blocks (1) are first and second recognition elements. They are arranged together to form a combined structure. They are held within a retention structure (70) (figures 23-25). The elements are cubes. The retention structure has a slanted back wall that displays the cubes at an angle.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (US 6,035,566). The plaque (15) is the first element. The plaque (16) is the second element. They are arranged to form a recognition structure. Each plaque has a textual recognition. The structure has a predetermined shape. Fisher does not explicitly disclose the recited method steps. The method steps, however, are inherent in the making and use of the Fisher system. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the recited method steps. The motivation would be to make and use the apparatus of Fisher.

31. Claims 22, 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wardle (US 4,137,657). Wardle shows an award designation device. Mounting strip (16) is the first element. Mounting strip (18) is the second element. The elements are arranged to form a combined structure. The plate (12) is the retention structure. In use, the first element is added to the top of the retention structure. Each additional element is added to the top of the preceding element. As many elements as desired can be added. Wardle does not explicitly disclose the recited method steps. The method steps, however, are inherent in the making and use of the Wardle system. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the recited method steps. The motivation would be to make and use the apparatus of Wardle.

32. Wardle discloses that the elements may represent awards or commendations for things like marksmanship, bravery, years of service, or the like. Any plural number of awards constitutes cumulative accomplishments. Marksmanship constitutes athletic accomplishments. Years in service constitutes completed project phases.

Furthermore, it is within the range of knowledge of the skilled artisan, and it would be obvious to make the awards represent anything the user desires.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Topitzes (US 5,611,160) shows a recognition structure with multiple attachable elements.

34. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Application/Control Number: 10/649,003

Page 9

Art Unit: 3617

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

Am 9-17-04
ANDREW D. WRIGHT
PRIMARY EXAMINER